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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,580

11/18/2008

Gerd Mansfeld

51777

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1609 7590 08/02/2010

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WASHINGTON,, DC 20036

EXAMINER

COLE, MONIQUE T

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

08/02/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,580	Applicant(s) MANSFELD ET AL.	
	Examiner M. COLE	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/18/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on June 16, 2006, is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the Examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 5, 6, 7, 8, 9, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 7,108,803 to Mansfeld et al. ("Mansfeld").

Mansfeld discloses a gas odorization composition and method for natural gas comprising a combination of methyl acrylate and ethyl acrylate; a C1-C4 pyrazine compound; and an antioxidant such as tert-butylhydroxytoluene, or hydroquinone monomethyl ether. Additionally, Mansfeld teaches that odorization using mercaptans, tetrahydrothiophene and thioethers is also customary. See col. 1, line 13 and lines 27-33; col. 2, lines 25-34; and col. 3, lines 4-9.

It is noted that Mansfeld is directed towards minimizing the presence of sulfur-containing compounds. However, it is clear that sulfur-containing compounds are conventionally utilized gas odorants, and Mansfeld does not serve to negate this knowledge in the art.

With respect to the amounts/ratio of the components in the recited mixture, it is the Examiner's position that absent a showing of criticality (i.e., evidence of superior or unexpected results) it is well within the skill of the art to modify the individual components in any manner so long as the odorant functionality is retained. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See MPEP § 2144.05.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mansfeld as applied to claims 1, 2, 3, 5, 6, 7, 8, 9, 10 and 12 above, and further in view of WO 03/044135 (USP 7,182,796 is being used as the English translation thereof)("WO '135").

Mansfeld fails to teach the compounds recited in component (C) as a part of the odorant mixture. However, WO '135 discloses the use of isovaleric acid as an odorant suitable for use in natural gas, which may be used in combination with other odorants.

It has been held that it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art. See MPEP § 2144.06. Therefore, given that both Mansfeld and WO '135 disclose combinations and

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method of odorizing natural gas, it would have been obvious to one of ordinary skill in the art to combine the individual odorant components of each reference in order to form a third mixture.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. COLE whose telephone number is 571-272-1463.

The examiner can normally be reached on M - Th (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. COLE
Examiner
Art Unit 1797

/Cephia D. Toomer/

Primary Examiner, Art Unit 1797